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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,130	01/09/2001	Benjamin Englander	P/1123-53	6441
2352 7590 10/11/2007 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			EXAMINER NGUYEN, THONG Q	
			ART UNIT 2872	PAPER NUMBER
			MAIL DATE 10/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/757,130

Applicant(s)

ENGLANDER, BENJAMIN

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/21/2007 has been entered.

### ***Response to Amendment***

2. The present Office action is made in response to the amendment filed on 8/21/2007. It is noted that in the amendment, applicant has amended claims 1 and 7; canceled claim 8 and added one independent claim, i.e., claim 9, into the application. A review of the device as recited in the amended claims and newly-added claim has resulted that the device of the new claim has similar scope as that of the amended claims, thus all claims 1-7 and 9 are examined in this Office action.

3. It is also noted that the list of claims as provided in the amendment of 8/21/07 has not complied with the requirement as set forth in 37 CFR 1.121. In particular, claim 9 is a new claim; however, the claim contains a deletion of the term "that" on line 23. In the spirit of cooperation, the amendment filed on 8/21/07 has been entered and claim 9 is considered as a new claim. Applicant should take into account the rule 37 CFR 1.121 in the process of amendment the claim(s) in any future communication.

***Specification***

4. A substitute specification without the claims is required pursuant to 37 CFR 1.125(a) because the numbers and the natures of the amendments render it difficult to consider the application or to arrange the papers for printing or copying, see 37 CFR 1.125.

Applicant should note that the application contains four amendments which made changes to the specification as filed on 8/10/2001; 6/20/2003; 7/15/2003 and 3/8/2004 in which some amendments made changes to the changes requested by a previous amendment, see the amendments filed on 6/20/03; 7/15/03 and 3/8/04, and thus some errors have been occurred. For instance, in the amendments filed on 6/20/03 and 7/15/03, applicant has requested to delete the phrase thereof "because the edges reflect light in a direction generally away from the school bus driver's eyes" on last two lines of the paragraph beginning at page 6, line 3; however, the mentioned phrase is shown in the mentioned paragraph of page 6 in the amendment filed on 3/8/04.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed

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within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-7 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a) Claim 1 is rejected under 35 USC 112, first paragraph because the disclosure, as originally filed, does not provide support for the following features which are recited in the claim as filed in the amendment of 8/21/07.

First, the disclosure as originally filed does not provide support for the features thereof "said mirror surface being size such that the entirety of the outer mirror is utilized to provide...said school bus" as recited on lines 4-8. Applicant should note that the disclosure as originally filed does not have any written description related to the size of the contoured outer surface of the mirror element and the

written description related to the images of both the front and at least one side of the school bus of the scene;

Second, the disclosure as originally filed does not provide support for the feature thereof "being mounted and structured to fixedly maintain said single integrated wide angle field of view...said school bus" as recited on lines 11-13. Applicant should note that all feature related to the mounting of the mirror to the school bus is provided in specification at page 4 which discloses a mounting of a mirror to a school bus of the prior art. See also page 3, the brief description of the drawings and the amendment to the drawings as filed on 1/29/01;

Third, the disclosure as originally filed does not provide support for the feature thereof "being treated with and comprising an antiglare material which is effective to reduce glare" as recited on lines 24-25. Applicant should note that the information related to the treatment to reduce glare is provided in page 3; however, the information has never disclosed that the so-called "antiglare material" is effective to reduce glare (examiner's emphasis); and

Fourth, the disclosure as originally filed does not provide support for the features thereof "whereby the entire of the mirror surface is utilized and the mirror surface...and whereby a mirror element of a smaller size is realizable" as recited on lines 26-29. Applicant should note that the disclosure as originally filed does not have any written description related to the so-called "whereby a mirror element of a smaller size is realizable" as claimed.

b) Claim 9 is rejected under 35 USC 112, first paragraph for the similar reasons as set forth in element a) above.

c) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiencies thereof.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-7 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 1 is rejected under 35 USC 112, second paragraph for the following reasons: First, each of the features thereof "the vehicle" (line 19) and "the non-treated surface" (line 28) lacks a proper antecedent basis; Second, it is unclear about the arrangement of the outer surface of the mirror element with respect to the vehicle (or the school bus) and the driver of the vehicle (or school bus) as recited in the features thereof "the contoured outer surface...of a driver" (lines 10-11) and "the outer mirror...facing toward the vehicle to which the mirror element is mounted" (lines 17-20). In other words, it is unclear to which direction the outer surface of the mirror element is mounted and faced from the two mentioned features. Applicant should note that a direction faced to the vehicle (or school bus) does not mean that the direction faces the direction of the vehicle (or school bus); Third, the feature thereof "said scene including images of both said front and said at least one side of said school bus" (lines 7-8) is indefinite

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because it is unclear what component(s)/system(s) is/are used to form images of both said front and said at least one side of said school bus onto the scene to be viewed by the driver of the school bus.

b) Claim 9 is rejected under 35 USC 112, first paragraph for the similar reasons as set forth in element a) above.

c) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiencies thereof

***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-6, and 9, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Stout (U.S. Patent No. 4,822,157, of record) in view of Falge (U.S. Patent No. 1,768,354, of record).

Stout discloses a school bus with a mirror assembly installed to a front fender of the bus for the purpose of providing the driver of the bus visual access to the area in front of the school bus as well as to the sides of the bus. See abstract and column 2 (lines 29-34). The mirror assembly as stated at column 2 and shown in figures 1-3 comprises a mirror element (26) having an oval ellipsoidal shape and configured as a convex, generally dome shaped and contiguous mirror surface with its contoured outer surface facing in a direction of the driver. The mirror surface of the mirror element inherently has a size wherein the entirety of the mirror surface is utilized to provide a single, integrated wide angle



filed of view of a scene which includes the front and at least one side of the bus wherein their images are viewed by the driver of the bus via the reflections from the mirror surface. The mirror assembly is secured to a mirror pole (20) via a securing means (48, 50, 52). The mirror pole (20) in turn is inherently secured to the front fender of the school bus. See column 3 and fig. 1. As such, the mirror assembly provides and maintains the scene which includes the front and at least one side of the bus wherein their images are viewed by the driver of the bus via the reflections from the mirror surface while the drive drives the bus. As a result of such structure, the school bus with the mirror assembly attached therein as provided by Stout meets all of the limitations of the device as claimed except a portion of the mirror element being treated for reducing glare.

The treatment on a portion of the mirror element, in particular, on an upper portion of the mirror, for the purpose of reducing glare is known to one skilled in the art as can be seen in the optical system provided by Falge. In particular, Falge discloses a mirror system having a mirror surface wherein the upper portion of the mirror is treated to reduce glare without rendering the treated portion opaque as to be non-reflective. See Falge, pages 1-2 and figs 1 and 8, for example. Regarding to the material used to treat the upper portion of the mirror, Falge discloses that one of the material used comprises black enamel, see column 3, lines 6-14, or translucent material such as celluloid or pyralin, colored green or other materials which effect a reduction in the intensity of light incident thereon, see column 4, lines 1-14.

Regarding to the dimension/size of the portion being treated (36) for reducing glare, in the embodiment of figure 8, the treated portion has an area of one-half of the upper one-third of the mirror (see page 2, column 4, lines 93-101). See also **In re Wertheim**, 541 F. 2d 257, 191 USPQ 90 (CCPA 1976), "the disclosure in the prior art of any value within a claimed range is an anticipation of that range." See also, **Titanium Metals Corporation of America**, 227 USPQ 773 (Fed. Cir. 1985), **In re Petering**, 301 F. 2d 676, 133 USPQ 275 (CCPA 1962). It is noted that the treated portion is located in spaced relation to and not in contact with any portion of the uppermost peripheral edge of the mirror surface along the vertical direction of the mirror surface.

Regarding to the feature that the treated portion is located in the area defined from an uppermost position on the contoured mirror surface and a straight notional line which bisects the mirror surface in the horizontal direction, such a feature is readable from the mirror having treated portion provided by Falge. In other words, in each embodiments shown in fig. 1 and fig. 8, the treated portion is located in a notional straight line which bisects the mirror surface in a horizontal direction. Applicant should note that notional straight line which bisects the mirror surface in a horizontal direction is merely that of an imaginary line, not a physical line or resulted from a mechanical construction/structure of the mirror surface.

With regard to the feature concerning the formation of the coating band as recited in claim 4, such a feature is directed to a method step and thus is not given a patentable weight. See **In re Dike**, 157 USPQ 581 (CCPA 1968).

Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the mirror assembly provided by Stout by making a portion of the upper one-third of the mirror as a treated portion as suggested by Falge for the purpose of providing a mirror assembly with a portion of its upper section having the function of reducing glare. It is also noted that the combined product as provided by Stout and Falge inherently will provide a reduction in glare caused by sun light during the operation of the school bus because the combined product is installed in a school bus which is operated in daytime for transportation students to school and back to their homes.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stout in view of Falge as applied to claim 1 above with or without Malifaud (U.S. Patent No. 3,199,114, of record).

The combined product as provided by Stout and Falge as described above meets all of the features recited in present claim 7 except the treated portion is located on one side relative to the minor axis of the mirror surface. However, such an arrangement of a treated portion with respect to the area of an optical element having a substantially oval shape as claimed is merely that of a preferred embodiment and no criticality has been disclosed. The support for this conclusion is found in the present specification in which applicant has taught that

the treated portion is extended on both side of the minor surface as can be seen in the embodiment described at pages 4-5 and illustrated in present figure 2A-2C. Furthermore, the use of an anti-glare portion which is located on one side of an optical element having an oval shape and on a side relative to a minor axis of the optical element is known to one skilled in the art as can be seen in the anti-glare system provided by Malifaud. See column 5 and fig. 5. Thus, absent any showing of criticality, it would have been obvious to one skilled in the art at the time the invention was made to utilize the teaching, i.e., use the antiglare portion on just one side of an optical element as suggested by Malifaud in the combined product provided by Stout and Falge by using a portion on just one side of the minor axis of a mirror surface which portion is necessary to the driver's field of view as a treated portion for reducing glare and simultaneously reducing the manufacture cost.

### ***Response to Arguments***

12. Applicant's arguments filed on 8/21/07, pages 6-8, have been fully considered but they are not persuasive for the following reasons.

First, applicant argues that the combined art does not disclose the invention as claimed. the examiner respectfully disagrees because all features recited in the claims are disclosed in the art of Stout in view of the art provided by Falge.

Applicant is respectfully invited to review the rejections of the claims as provided in this Office action.

Second, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Third, applicant has argued that the mirror provided by Falge has a large side and not is a mirror installed in a school bus wherein the mirror has a size to provide a single integrated wide angle field of view as that of the present claims. The Examiner respectfully disagreed because the mirror has a size to provide a single integrated wide angle field of view is clearly provided by the Stout, the primary reference. The art of Falge, the secondary reference, is used in combination with the art of Stout, the primary reference, is for the purpose of showing that the treatment on a portion of the mirror element, in particular, on an upper portion of the mirror, for the purpose of reducing glare. In response to applicant's argument that the mirror provided by Falge is large mirror so it cannot use with a school bus, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

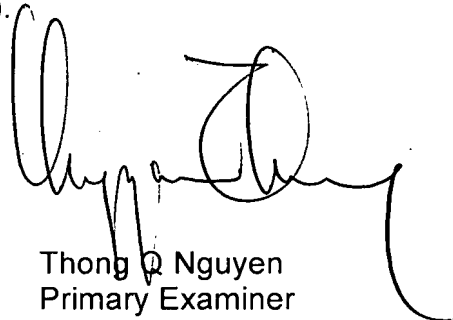
**Conclusion**

13. The additional U.S. patents are cited as of interest in that each discloses a mirror assembly installed on a school bus. It is noted that the use of an opaque or non-reflective bans around the peripheral section of the mirror near the edges is disclosed in the Patent No. 6,293,679.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q Nguyen  
Primary Examiner  
Art Unit 2872